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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/941,863

08/30/2001

Tadao Takagi

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11/28/2006

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,863

Applicant(s)

TAKAGI, TADAO

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

14. The Request filed on 8/24/2006 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/941,863 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

15. Claims 13 and 21 have been cancelled; therefore, Claims 1-12, 14-20, and 22-31 are currently pending in application 09/941,863.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. **Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** The claim is directed to a statutory class of an apparatus, which is an electrical signal (carrier wave) that contains information. An electrical signal is a non-tangible object, it is not being received anywhere nor is it being transmitted. There appellant is merely claiming the signal itself, which is considered to be non-statutory subject matter.

18. A claimed carrier wave is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.
19. "The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.
20. A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.
21. The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by

hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.

22. A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

Claim Rejections - 35 USC § 112

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

24. Claims 1-12, 14-20, and 22-31 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

25. The claims are generally narrative and indefinite, failing to conform with current U.S.

practice. They appear to be a literal translation into English from a foreign document and

are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

27. Claims 1, 2, 5-11, 14, 16-20, 22, and 24-28 are rejected under 35 U.S.C. 102(e) as

being anticipated by Wallis et al. (US 2001/20051884 A1).

28. As per **independent Claim 1**, Wallis discloses a product maintenance method,

comprising: receiving access regarding a repair request for a product from a terminal of a

user who uses the product via the Internet (abstract); transmitting screen information with

regard to repair conditions set for repairing the product to the terminal of the user via the

Internet; and receiving an agreement to the repair conditions and a repair request for the

product from the terminal of the user via the Internet (Fig.3, Warranty repair request received and approved).

29. As per Claim 2, Wallis discloses transmitting screen information for displaying an input screen to enable entry of user information including information with regard to a product to be repaired to the terminal of the user via the Internet; receiving the user information from the terminal of the user via the Internet; assigning a repair order ID corresponding to the repair request is assigned; storing the user information in a storage device together with said repair order ID; and transmitting information indicating said repair order ID to the terminal of the user via the Internet (Fig.3-5, Para 0042-0045).
30. As per **independent Claims 5, 16, and 24**, Wallis discloses a product maintenance method, comprising: receiving a repair request for a product from a terminal of a user who uses the product via the Internet; and transmitting information regarding the product which *enables* a transport operator to select a packing box corresponding to the product the repair request for which has been received (Parcel delivery service has access to item information over network), and information instructing delivery of the selected packing box to the user, to a server of the transport operator via the Internet (Fig.3-5, Para 0042-0045).
31. As per Claim 6, Wallis discloses transmitting information instructing that the product packed in the packing box be picked up from the user transmitted to the server of the transport operator via the Internet; and transmitting information instructing delivery of the product that has been repaired to the user, to the transport operator via the Internet upon completion of repair of the product.

32. As per Claim 7, Wallis discloses transmitting an repair cost estimate for the product, the repair request for which has been received, to the terminal of the user via the Internet prior to starting a repair work; obtaining a repair approval based upon said estimate from the user via the Internet; and said repair cost estimate including a price of the packing box and a price of collecting and delivering the product.
33. As per **independent Claims 8, 17, and 25**, Wallis discloses a product maintenance method comprising: receiving a repair request for a product from a terminal of a user who uses the product via the Internet; transmitting a repair cost estimate for the product (Warranty information approval – cost would be zero), the repair request for which has been received, to the terminal of the user via the Internet; and obtaining a repair approval based upon said estimate from the user via the Internet (Fig.3-5, Para 0042-0045, initial repair request is a repair approval of user based on warranty approval).
34. As per Claims 9, 18, and 26, Wallis discloses transmitting an estimate of a repair completion date to the terminal of the user together with said estimate for the repair cost.
35. As per Claims 19 and 27, Wallis discloses wherein said repair cost includes fees for a price of a packing box delivered to the product user and fees for delivering the packing box and delivering the product to be repaired.
36. As per **independent Claims 10, 20, and 28**, Wallis discloses a product maintenance method, comprising: receiving a repair request for a product from a terminal of a user who uses the product via the Internet; assigning a repair order ID corresponding to the repair request; and transmitting information indicating said repair order ID to the terminal

of the user via the Internet (Fig.3-5, Para 0042-0045, warranty information is saved on network and accessible to all parties).

37. As per Claim 11, Wallis discloses storing a repair progress status for the product at each stage including a delivery preparation status in a storage device in correspondence to said repair order ID; and when an inquiry on the repair progress status is made from the terminal of the user by indicating said repair order ID via the Internet, obtaining the repair progress status corresponding to said repair order ID from said storage device and transmitting the repair progress status thus obtained to the terminal of the user via the Internet.

38. As per **independent Claims 14 and 22**, Wallis discloses a product maintenance business system for offering product repair services, comprising: a server of a product maintenance business operator that is connected with a terminal of a product user, a server of a transport operator and a server of a repair fee collector via the Internet, wherein said server of the product maintenance business operator executes: processing for displaying repair conditions set for a product on a homepage on the Internet; processing for inputting information from the product user indicating an agreement to the repair conditions and storing said information in a storage device; and processing for assigning a repair order number and notifying the product user of the repair order number via the Internet (Fig.3-5, Para 0042-0045, warranty information is saved on network and accessible to all parties).

Claim Rejections - 35 USC § 103

39. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

40. Claims 3, 4, 12, 15, 23, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallis in view of Official Notice.

41. As per **independent Claims 3, 15, 23, and 29**, Wallis discloses a product maintenance method, comprising: receiving a repair request for a product from a terminal of a user who uses the product via the Internet; the repair request for which has been received, based upon product information stored in a database; and transmitting information instructing delivery of the selected packing box to the user, to a server of a transport operator via the Internet (Fig.3-5, Para 0042-0045, Parcel delivery service is contacted and the Parcel delivery service has network access to item information).

42. However, Wallis does not expressly disclose wherein the Parcel delivery service selects a packing box corresponding to the product.

43. However, Official Notice is taken that is was well known to one of ordinary skill in the art (shipping) at the time the invention was made that a parcel service was able to provide appropriate packaging for a parcel delivery, given the proper item specifications (Parcel delivery service has access to specific item information); for the purpose of providing

proper packaging of all items (shapes and sizes), given the multitude of customer circumstances.

44. As per Claim 4, Wallis discloses transmitting information instructing that the product packed in the packing box be picked up from the user to the server of the transport operator via the Internet; and transmitting information instructing delivery of the product that has been repaired to the user, to the transport operator via the Internet upon completion of repair of the product (Fig.3-5, Para 0042-0045, item transport and repair tracking).
45. As per Claim 30, Wallis discloses wherein said computer-readable computer program product is a recording medium on which said program is recorded.
46. As per Claim 31, Wallis discloses wherein: the computer-readable computer program product is a carrier wave in which the program is embodied as a data signal (networked based system).
47. As per **independent Claim 12**, Wallis discloses a product maintenance method, comprising: receiving access regarding a repair request for a product from a terminal of a user who uses the product via the Internet; transmitting screen information with regard to repair conditions set for repairing the product to the terminal of the user via the Internet; transmitting screen information for displaying an input screen to enable entry of user information including information with regard to the product to be repaired to the terminal of the user via the Internet; receiving an agreement to the repair conditions and the user information from the terminal of the user via the Internet (warranty agreement); determining to receive the repair request for the product; assigning a repair order ID

corresponding to the repair request (repair tracking); storing the user information in a storage device together with said repair order ID; transmitting information indicating said repair order ID to the terminal of the user via the Internet; the repair request for which has been received, based upon product information stored in a database; transmitting information instructing delivery of the selected packing box to the user, to a server of a transport operator via the Internet (contacting Parcel delivery service); transmitting information instructing that the product packed in the packing box be picked up from the user, to the server of the transport operator via the Internet; transmitting a repair cost estimate for the product (warranty information approval – cost would be zero), the repair request for which has been received, to the terminal of the user via the Internet prior to starting a repair work; obtaining a repair approval based upon said estimate from the terminal of the user via the Internet (initial repair request is a repair approval of user based on warranty approval); storing a repair progress status for the product at each stage including a delivery preparation status in a storage device in correspondence to said repair order ID; when an inquiry on the repair progress status is made from the terminal of the user by indicating said repair order ID via the Internet, obtaining the repair progress status corresponding to said repair order ID from the storage device and transmitting the repair progress status thus obtained to the terminal of the user via the Internet (user has access to tracking information); transmitting information instructing delivery of the product that has been repaired to the user, to the server of the transport operator via the Internet upon completion of repair of the product (contact Parcel delivery service); and transmitting information instructing that a repair fee be collected to a server

of a repair fee collector via the Internet upon completion of the repair on the product (under warranty conditions fee would be zero) (Fig.3-5, Para 0042-0045).

48. However, Wallis does not expressly disclose wherein the Parcel delivery service selects a packing box corresponding to the product.

49. However, Official Notice is taken that is was well known to one of ordinary skill in the art (shipping) at the time the invention was made that a parcel service was able to provide appropriate packaging for a parcel delivery, given the proper item specifications (Parcel delivery service has access to specific item information); for the purpose of providing *proper* packaging of all items (shapes and sizes), given the multitude of customer circumstances.

Response to Arguments

50. Applicant's arguments filed 8/24/2006, with respect to Claims 1-12, 14-20, and 22-31, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

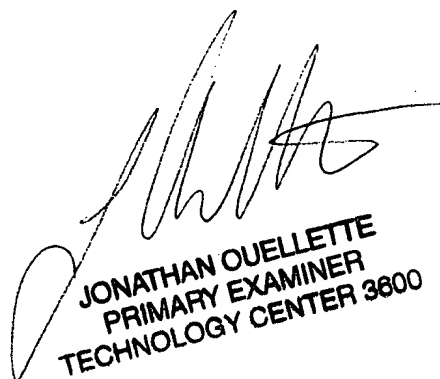
51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

52. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

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53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
55. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

jo
November 27, 2006



JONATHAN OUELLETTE
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600